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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/705,822	11/13/2003	Ajaipal Singh Virdy	06975-218003	7862
26171 7590 02/01/2007 FISH & RICHARDSON P.C. P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022			EXAMINER WOO, ISAAC M	
			ART UNIT 2166	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		02/01/2007	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/705,822

Applicant(s)

VIRDY, AJAIPAL SINGH

Examiner

Isaac M. Woo

Art Unit

2166

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 November 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 39-57 is/are pending in the application.
- 4a) Of the above claim(s) 39-40 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 41-57 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. This action is in response to Applicant's Amendment, filed on November 30, 2007 have been considered but are deemed moot in view of new ground of rejections below.

2. Claims 41-57 are newly added. Claims 39-40 are withdrawn. Claims 41-57 are presented for this office action (Claims 1-38 are canceled).

### ***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claim 57 is rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter.

As set forth in MPEP 2106 (II) (A):

*A. Identify and Understand Any Practical Application Asserted for the Invention*

*The claimed invention as a whole must accomplish a practical application. That is, it must produce a "useful, concrete and tangible result." State Street, 149 F.3d at 1373, 47 USPQ2d at 1601-02. The purpose of*

Art Unit: 2166

this requirement is to limit patent protection to inventions that possess a certain level of "real world" value, as opposed to subject matter that represents nothing more than an idea or concept, or is simply a starting point for future investigation or research (*Brenner v. Manson*, 383 U.S. 519, 528-36, 148 USPQ 689, 693-96); *In re Ziegler*, 992, F.2d 1197, 1200-03, 26 USPQ2d 1600, 1603-06 (Fed. Cir. 1993)). Accordingly, a complete disclosure should contain some indication of the practical application for the claimed invention, i.e., why the applicant believes the claimed invention is useful.

Apart from the utility requirement of 35 U.S.C. 101, usefulness under the patent eligibility standard requires significant functionality to be present to satisfy the useful result aspect of the practical application requirement. See *Arrhythmia*, 958 F.2d at 1057, 22 USPQ2d at 1036. Merely claiming nonfunctional descriptive material stored in a computer-readable medium does not make the invention eligible for patenting. For example, a claim directed to a word processing file stored on a disk may satisfy the utility requirement of 35 U.S.C. 101 since the information stored may have some "real world" value. However, the mere fact that the claim may satisfy the utility requirement of 35 U.S.C. 101 does not mean that a useful result is achieved under the practical application requirement. The claimed invention as a whole must produce a "useful, concrete and tangible" result to have a practical application.

Claim 57 is non-statutory. Because claim 57 includes limitations of, "System for performing a search of network accessible contents, ....", and " means for .....", which does not include *physical structure of the machine in terms of its hardware or hardware and software combination*. Therefore, claim 57 is software per se. Thus, the claim 57 is

not a statutory and should be rejected under 35 U.S. C. § 101 as not being tangible.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 41-57 are rejected under 35 U.S.C. 102(e) as being anticipated by Dunworth et al (U.S. Patent No. 5,930,474, hereinafter, "Dunworth").

With respect to claim 41, Dunworth teaches traversing a network of web documents to identify business names and geographic data associated with the web documents (col.2, lines 59-67 to col. 3, lines 1-44); identifying a business name (i.e., 328, Yellow page list description database in fig. 3) and geographic data (i.e., geography database in fig. 3) associated with a particular web page; determining web page identifying data for the particular web page (i.e., url, HTML form, col. 7, lines 31-64); extracting the identified business name and geographic data associated with the particular web page (i.e., 210 and 328 in fig. 3 created from internet searching, col. 10, lines 41-67 to col. 11, lines 1-67 to col. 12, lines 1-67) based on the extracted business

Art Unit: 2166

name and geographic data, accessing a business directory to determine a business category code (245 in fig. 2C, col. 10, lines 7-30) that is associated with the extracted business name and geographic data (fig. 3, col. 10, lines 41-67 to col. 11, lines 1-67 to col. 12, lines 1-67); storing the web page identifying data and the business category code in association with one another and within an entry in an electronic data store (210 and 328 in fig. 3, col. 10, lines 41-67 to col. 11, lines 1-67 to col. 12, lines 1-67); receiving a query from a user, the query being related to a business category (i.e., 610 request yellow page search in fig. 6, col. 15, lines 53-67 to col. 16, lines 1-47); identifying, within the electronic data store, one or more entries that include a business category code that is associated with the business category of the query (i.e., 530 in fig. 6, col. 15, lines 53-67 to col. 16, lines 1-47); and returning a result to the user, the result including web page identifying data included in the identified one or more entries (i.e., 330 and 335 in fig. 6, col. 15, lines 53-67 to col. 16, lines 1-47).

With respect to claims 42-45, Dunworth teaches the geographic data includes a zip, local area exchange code, area code and city and a state (fig. 17, col. 24, lines 28-67).

With respect to claim 46, Dunworth teaches web page identifying data includes a uniform resource locator for the particular web page (i.e., url, HTML form, col. 7, lines 31-64).

With respect to claim 47, Dunworth teaches storing the geographic data in the entry within the electronic data store in which the business category code and the web page identifying data are stored (i.e., 210 and 328 in fig. 3).

With respect to claim 48, Dunworth teaches business category code is configured to support a search (col.2, lines 59-67 to col. 3, lines 1-44).

With respect to claim 49, Dunworth teaches traverse a network of web documents to identify business names and geographic data associated with the web documents (col.2, lines 59-67 to col. 3, lines 1-44); identify a business name (i.e., 328, Yellow page list description database in fig. 3) and geographic data (i.e., geography database in fig. 3) associated with a particular web page; determine web page identifying data for the particular web page (i.e., url, HTML form, col. 7, lines 31-64); extract the identified business name and geographic data associated with the particular web page (i.e., 210 and 328 in fig. 3 created from internet searching, col. 10, lines 41-67 to col. 11, lines 1-67 to col. 12, lines 1-67) based on the extracted business name and geographic data, accessing a business directory to determine a business category code (245 in fig. 2C, col. 10, lines 7-30) that is associated with the extracted business name and geographic data (fig. 3, col. 10, lines 41-67 to col. 11, lines 1-67 to col. 12, lines 1-67); store the web page identifying data and the business category code in association with one another and within an entry in an electronic data store (210 and 328 in fig. 3, col. 10, lines 41-67 to col. 11, lines 1-67 to col. 12, lines 1-67); receive a

Art Unit: 2166

query from a user, the query being related to a business category (i.e., 610 request yellow page search in fig. 6, col. 15, lines 53-67 to col. 16, lines 1-47); identify, within the electronic data store, one or more entries that include a business category code that is associated with the business category of the query (i.e., 530 in fig. 6, col. 15, lines 53-67 to col. 16, lines 1-47); and return a result to the user, the result including web page identifying data included in the identified one or more entries (i.e., 330 and 335 in fig. 6, col. 15, lines 53-67 to col. 16, lines 1-47).

With respect to claims 50-53, Dunworth teaches the geographic data includes a zip, local area exchange code, area code and city and a state (fig. 17, col. 24, lines 28-67).

With respect to claim 54, Dunworth teaches web page identifying data includes a uniform resource locator for the particular web page (i.e., url, HTML form, col. 7, lines 31-64).

With respect to claim 55, Dunworth teaches storing the geographic data in the entry within the electronic data store in which the business category code and the web page identifying data are stored (i.e., 210 and 328 in fig. 3).

With respect to claim 56, Dunworth teaches business category code is configured to support a search (col.2, lines 59-67 to col. 3, lines 1-44).



With respect to claim 57, Dunworth teaches traversing a network of web documents to identify business names and geographic data associated with the web documents (col.2, lines 59-67 to col. 3, lines 1-44); identifying a business name (i.e., 328, Yellow page list description database in fig., 3) and geographic data (i.e., geography database in fig. 3) associated with a particular web page; determining web page identifying data for the particular web page (i.e., url, HTML form, col. 7, lines 31-64); extracting the identified business name and geographic data associated with the particular web page (i.e., 210 and 328 in fig. 3 created from internet searching, col. 10, lines 41-67 to col. 11, lines 1-67 to col. 12, lines 1-67) based on the extracted business name and geographic data, accessing a business directory to determine a business category code (245 in fig. 2C, col. 10, lines 7-30) that is associated with the extracted business name and geographic data (fig. 3, col. 10, lines 41-67 to col. 11, lines 1-67 to col. 12, lines 1-67); storing the web page identifying data and the business category code in association with one another and within an entry in an electronic data store (210 and 328 in fig. 3, col. 10, lines 41-67 to col. 11, lines 1-67 to col. 12, lines 1-67); receiving a query from a user, the query being related to a business category (i.e., 610 request yellow page search in fig. 6, col. 15, lines 53-67 to col. 16, lines 1-47); identifying, within the electronic data store, one or more entries that include a business category code that is associated with the business category of the query (i.e., 530 in fig. 6, col. 15, lines 53-67 to col. 16, lines 1-47); and returning a result to the user, the result

Art Unit: 2166

including web page identifying data included in the identified one or more entries (i.e., 330 and 335 in fig. 6, col. 15, lines 53-67 to col. 16, lines 1-47).

### ***Conclusion***

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

**Contact Information**

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Isaac M. Woo whose telephone number is (571) 272-4043. The examiner can normally be reached on 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain T. Alam can be reached on (571) 272-3978. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Isaac Woo  
January 30, 2007